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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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DENNIS M. O'CONNOR

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EXAMINER

NGUYEN, HUY THANH

ART UNIT

PAPER NUMBER

2616

19

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/223,516

Applicant(s)

O'CONNOR ET AL.

Examiner

HUY T NGUYEN

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-14 and 40-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-14 and 40-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, filed 03 June 2004, with respect to the final rejection(s) of claim(s) 12-14 and 40-44 under USC 35 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the new and cited prior art .

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 12,13,14 and 40-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Nielsen et al (5,778,137).

Regarding claim 40, Nielsen discloses a transmitter comprising: a transmission device to broadcast a video program to a large number of receivers ; and a broadcast encoder to insert, in the course of said broadcast of said program, a control signal (reference level) to said receivers to record a replay

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(column 1, lines 50-65, column 2, lines 30-36, column 3, lines 1-41, column 4, lines 5-20).

Method claims 41 corresponds to apparatus claim 40, therefore method claim 40 is rejected by the same reason as applied to apparatus claim 40.

Regarding claim 12, Nielsen further the transmission device is a cable television transmitter (column 3, line 65 to column 4 line 5).

Regarding claim 13, Nielsen further teaches the transmission device is a satellite television transmitter (column 3, line 65 to column 4 line 5, column 3, line 65 to column 4 line 5).

Regarding claim 14, Nielsen further teaches that the transmission device is a over the air broadcast television transmitter (column 3, lines 15-20, column 3, line 65 to column 4 line 5).

Regarding claim 42, Nielsen further broadcasting the control signal over the vertical blanking interval (column 3, lines 8-10).

4. Claims 14,40-41 and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Heo et al (2002/0176689A1).

Regarding claim 40, Heo discloses a transmitter comprising: a transmission device to broadcast a video program to a large number of receivers (page 1 section 0021); and a broadcast encoder to insert, in the course of said broadcast of said program, a control signal (highlight code) to said receivers to record a replay. Since the highlight portion is recorded and is played back later for viewing, the recoded highlight portion is considered as the recited replay (page 2, sections 0023 –0035).

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Method claims 41 corresponds to apparatus claim 40, therefore method claim 40 is rejected by the same reason as applied to apparatus claim 40.

Regarding claim 14, Heo further teaches that the transmission device is a over the air broadcast television transmitter (page 1 section 0021).

Regarding claim 44, Heo further teaches a start queue and an end queue to control the recording of said replay (start code and end code)

5. Claims 14, 40,41 rejected under 35 U.S.C. 103(a) as being unpatentable over Arika (JP361017242A).

Regarding claim 40, Arika discloses a transmitter comprising: a transmission device to broadcast a video program to a large number of receivers; and a broadcast encoder to insert, in the course of said broadcast of said program, a control signal (start recording code and end recording code of sub voice multiplexed with video of the broadcast to said receivers to record a replay (Figs. 1 and 2, Abstract and contitution).

Method claims 41 corresponds to apparatus claim 40, therefore method claim 40 is rejected by the same reason as applied to apparatus claim 40.

Regarding claim 14, Arika further teaches that the transmission device is a over the air broadcast television transmitter.

Regarding claim 44, Arika further teaches a start queue and an end queue to control the recording of said replay (start code and end code).

6. Claims 14, 40,41,42 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (5,526,130).

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Regarding claim 40, Kim discloses a transmitter comprising: a transmission device to broadcast a video program to a large number of receivers; and a broadcast encoder to insert, in the course of said broadcast of said program, a control signal (start time code and end time code signals used to control the recording of the broadcast signal) to said receivers to record a replay (Fig. 1,7,8 column 5, lines 55-60, column 6, line 57 to column 7, line 10, column 8 line 55 to column 9, line 25).

Method claims 41 corresponds to apparatus claim 40, therefore method claim 40 is rejected by the same reason as applied to apparatus claim 40.

Regarding claim 14, Kim further teaches that the transmission device is a over the air broadcast television transmitter .

Regarding claim 42, Kim further teaches including the control signal in a vertical blanking interval.

Regarding claim 44, Kim further teaches that the control signal comprising a start cue and an end cue (state time and end time)

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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8. Claims 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heo in view of Vogel (5,485,219).

Heo fails to specifically teach that the control signal recording command is transmitted in a vertical blanking interval. However, it is noted that transmitting a control signal inserted in a vertical blanking interval of a broadcast program is well known in the art as taught by Vogel. Vogel at figure 3, teaches means for inserting control signal in a vertical interval of a video transmission to reduce the effect of the control signal on the video portion. It would have been obvious to one of ordinary skill in the art to modify Heo Vogel by using a inserting means as taught by Vogel for inserting the control signal into a vertical blanking interval of the broadcast signal in order to reduce the interference between the control signal and the video signal of the broadcast signal.

9. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heo in view of Woo (5,485,219).

Regarding claims 12 and 13 Heo does not specify that the transmitting device is a satellite or cable transmitter. However, it is noted that using a satellite or cable transmitters for transmitting a broadcast signal is well known in the art as taught by WOO. Therefore, it would have been obvious to one of ordinary skill in the art to modify Heo with Woo by using the satellite and cable as alternative method for transmitting the broadcast signal to the receivers.

10. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over

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Heo in view of Nagasaka et al (5,818,493).

Heo fails teach using information to determined a displaying format size of a replay .

Nakasaka teaches using information for video data to indicate a display size of video data on a monitor (column 6, lines 55-65).

It would have been obvious to one of ordinary sill in the art t modify Heo with the teaching of Nakasaka by providing the information for the size of the replay thereby enhancing the capacity of a monitor for preserving the remain area on the monitor for other display .

11. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nelsen in view of Nagasaka et al (5,818,493).

Nielsen fails teach using information to determined a displaying format size of a replay .

Nakasaka teaches using information for video data to indicate a display size of video data on a monitor (column 6, lines 55-65).

It would have been obvious to one of ordinary sill in the art t modify Nielsen with the teaching of Nakasaka by providing the information for the size of the replay thereby enhancing the capacity of a monitor for preserving the remain area on the monitor for other display

Conclusion

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12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Evans and Lee et al teaches apparatus for recording broadcast portion of interest as a replay .

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T NGUYEN whose telephone number is (703) 305-4775. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ,acting, Thai Tran can be reached on (703) 305-4725. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.N


HUY NGUYEN
PRIMARY EXAMINER